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09/706,112	11/03/2000	Jerome Swartz	04873-031003	5868

7590

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EXAMINER

FUREMAN, JARED

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 03/15/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/706,112

Applicant(s)

SWARTZ, JEROME

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2001.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 20-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 20-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 6, 10.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **DETAILED ACTION**

Receipt is acknowledged of the IDS filed on 4/27/2001, the amendment filed on 11/19/2001, and the IDS filed on 11/20/2001. A reference was lined through on the IDS filed on 11/20/2001, since there was no copy in the file and the reference was not readily available to the examiner.

#### ***Terminal Disclaimer***

1. The terminal disclaimer filed on 11/19/2001 disclaiming the terminal portion of any patent granted on this application which would extend beyond the expiration date of U.S. Pat. 5,825,402 has been reviewed and is accepted. The terminal disclaimer has been recorded.

#### ***Claim Objections***

2. Claim 22 is objected to because of the following informalities: In line 1, "in" should be replaced with --is--. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 103***

3. Claims 20, 21, and 23-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi, deceased (US 5,057,943, cited by applicant) in view of Christopher et al (US 5,227,617, cited by applicant).

Re claims 20 and 23-25: Takahashi teaches an apparatus for writing optical indicia on a medium 1. The apparatus includes: a central processing unit (CPU) (A/O controller 6) for controlling the apparatus, a light source (laser 2) for generating a light beam (laser beam) suited for writing the optical indicia on the medium, a scanning element (A/O modulator 5 and polygon mirror 70) under control of the CPU that directs

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the light beam at the medium in a pattern prescribed by the CPU, the light beam (laser beam) is pulsed by the A/O modulator 5 (see figures 1, 4, column 1 lines 6-12, column 2 lines 43-66, and column 3 line 22 - column 4 line 9).

Takahashi fails to teach a housing configured to be hand held, and an interface for connecting the apparatus to external devices.

Christopher et al teaches a hand held apparatus 10 for writing optical indicia on a medium. The apparatus includes: a housing (handle 20 and housing 22) configured to be hand held, and an interface 122 for connecting the apparatus to external devices (see figures 1, 2, 4, column 3 line 60 - column 4 line 29, column 5 lines 51-57, and column 6 lines 49-54).

In view of Christopher et al's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate, with the apparatus as taught by Takahashi, a housing configured to be hand held, and an interface for connecting the apparatus to external devices, in order to provide a portable hand held apparatus which can be easily carried to a desired location of use, thereby increasing the versatility of the apparatus, and in order to provide the ability to communicate with an external device, such as a host computer, thereby increasing the data storage/processing capabilities of the apparatus.

Re claim 21: Takahashi as modified by Christopher et al fails to specifically teach the optical indicia being alphanumeric characters.

However, Official Notice is taken that at the time of the invention it was well known to those of ordinary skill in the art to write optical indicia comprising alphanumeric characters on a medium.

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to integrate, with the apparatus as taught by Takahashi as modified by Christopher et al, the optical indicia including alphanumeric characters, in order to provide human readable indicia on the medium, which would simplify organization/record keeping, since the medium would not require machine reading to be identified.

4. Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Takahashi as modified by Christopher as applied to claim 20 above, and further in view of Miyagawa (US 5,488,489, cited by applicant).

Takahashi also teaches the medium 1 being photosensitive (see column 3, lines 31-34).

Takahashi as modified by Christopher et al fails to teach the medium being thermal sensitive.

Miyagawa teaches that a thermal sensitive medium is an art recognized functional equivalent of a photosensitive medium (see column 8, lines 24-28).

In view of Miyagawa's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to replace the photosensitive medium, as taught by Takahashi as modified by Christopher et al, with a thermal sensitive medium, since they are art recognized functional equivalents.

***Response to Arguments***

5. Applicant's arguments filed 11/19/2001 have been fully considered but they are not persuasive.

In response to applicant's argument Takahashi merely teaches a scanner for scanning pages fed past a roller, the scanner has no provision for writing an image, it is completely lacking in relevance to the claimed invention (see page 1 of the response filed on 11/19/2001), applicant's interpretation of the Takahashi reference is clearly incorrect, for example, Takahashi states, "The present invention relates to an image scanning apparatus which conducts a two-dimensional scanning of an object with a light beam so as to record or read an image ..." (see column 1 lines 6-9), "Fig. 1 is a schematic illustration of an embodiment which records a two-dimensional image by a combination of a main scanning conducted by an optical scanning system ..." (see column 3 lines 25-28). Thus, it is clear that the system has provision for writing an image and is relevant to the claimed invention.

In response to applicant's argument that Takahashi is incapable of being hand-held (see page 1 of the response filed on 11/19/2001), Takahashi is silent as to the size, shape, and weight of the apparatus, thus, applicant's argument is merely based upon speculation, as it is unknown whether the apparatus is capable of being hand-held. To establish a prima facie case of obviousness, the office action relies upon the secondary teachings of Christopher et al. Christopher et al teaches a hand held apparatus 10 for writing optical indicia on a medium. The apparatus includes: a housing (handle 20 and

housing 22) configured to be hand held (see figures 1, 2, 4, column 3 line 60 - column 4 line 29, column 5 lines 51-57, and column 6 lines 49-54).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Christopher et al teaches a hand-held apparatus for writing optical indicia on a medium, the apparatus comprising: a housing configured to be hand-held. Clearly the advantage of portability, derived from a housing configured to be hand-held, was well within the knowledge generally available to one of ordinary skill in the art.

Furthermore, the fact that a claimed device is portable or movable is not sufficient by itself to patentably distinguish over an otherwise old device unless there are new or unexpected results. See *In re Lindberg*, 194 F.2d 732, 93 USPQ 23 (CCPA 1952). Applicants have not shown that using a housing configured to be hand-held produces any unexpected results.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208

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USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

### ***Conclusion***

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-F, first Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-7722 for regular communications and (703) 308-7722 for After Final communications.




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

  
jjf

March 11, 2002

  
MICHAEL G. LEE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2800